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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,370	12/20/2001	Robert Uyeki	23484-031	9654
36614	7590	12/19/2005	EXAMINER	
MANATT PHELPS AND PHILLIPS ROBERT D. BECKER 1001 PAGE MILL ROAD, BUILDING 2 PALO ALTO, CA 94304				RUHL, DENNIS WILLIAM
		ART UNIT		PAPER NUMBER
		3629		

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/027,370	UYEKI, ROBERT
<b>Examiner</b>	Dennis Ruhl	<b>Art Unit</b>
		3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 06 October 2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-5,7-20 and 22-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5,7-20,22-28 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/6/05 has been entered.

The examiner will address applicant's remarks at the end of this office action. Currently claims 1-5,7-20,22-28 are pending.

2. The amendment filed 10/6/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: See the 112,1<sup>st</sup> rejection for the specifics of what is considered to be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5,7-20,22-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention. The specification as originally filed did not disclose the limitation of "wherein the designated area includes no hardware at the parking area". This is considered new matter. The specification as originally filed discloses that in one embodiment the vehicle monitoring means is data that is entered into the terminal at the parking area, and this would require some hardware at the parking area, namely the terminal. Having "no hardware" at the designated area is new matter. Also, don't you at least need a GPS unit in the vehicle, and if the vehicle is at the parking area this would constitute hardware at the parking area? Having a function performed with no hardware is not possible. The examiner also notes that applicant has amended claim 9 to recite that the monitoring means further comprises user data submitted by the user at the terminal, and clearly a terminal at the designated area is then required. Because the monitoring means includes the terminal that the user is to use to enter data, this requires a terminal at the designated area; otherwise how would one enter the data? The examiner also takes notice that applicant did not state for the examiner where support can be found in the specification as originally filed for the newly added claim language. Upon a review of the specification none can be found.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5,7-20,22-28, are rejected under 35 U.S.C. 102(b) as being anticipated by Klein et al. (5726885).

For claims 1-4,8,18, Klein discloses a vehicle renting system. Klein discloses a terminal (HA or the card reader of each car), register means and central computer (D) with computing means, vehicle monitoring means (col. 6, lines 1-12), designated area (H1), communication means (1), and information device (either part of HA or 1). With respect to the limitation of the vehicle monitoring means being “geo-fencing means”, as this is best understood by the examiner this is a recitation to a GPS system, which is disclosed by Klein. The instant specification discloses the fact that “geo-fencing means” is a GPS system. The GPS system of Klein monitors the use of the vehicle and monitors the location of the vehicles so that they can be tracked and accounted for as claimed. The recited functions for both the “vehicle monitoring means”/“geo-fencing means” are present in the GPS system of Klein and satisfy what is claimed. Additionally, geo-fencing is utilization of a GPS system for vehicle tracking so reciting “geo-fencing” is still just a recitation to a GPS system for the monitoring of the vehicles. Claim 2 also reinforces this position taken by the examiner because claim 2 is reciting a GPS system (exactly what Klein discloses). Because GPS uses satellites located in

space and GPS units in the vehicles, there is no hardware at the designated area because they are in the vehicles.

For claims 5,14, applicant is reciting a method limitation and this has been considered to the extent that the prior art must be capable of doing what is claimed. Klein is fully capable of operating as claimed. Intended use limitations in article claims will be given minimal patentable weight.

For claims 7,20, the examiner feels that they read on a GPS device that is disclosed by Klein. A GPS device provides the ability to monitor the entry and exiting of vehicles from the designated area. A GPS unit is the device that is used to allow the function of the means plus function language to occur. “Geo-fencing” is and requires a GPS unit.

For claims 9-13,19, applicant has recited data and nothing more. This is considered to be non-functional descriptive material and because Klein uses input data, Klein anticipates this claim. The kind of data being used is non-functional descriptive material.

For claims 15,16,17, the card reader of Klein is vehicle mounted and reads information from an identification card as claimed. The kind of data being used is non-functional descriptive material.

For newly added method claims 22-28, Kline discloses the providing of a designated area for a user to obtain a vehicle from. The providing “geo-fencing means” is satisfied by the GPS system that Klein uses to track and monitor the vehicles with. Geo-fencing is and requires a GPS unit. Kline discloses that users can request the use

of a vehicle at terminal HA, where the terminal accepts user input information, and can determine whether or not a vehicle is available for the user based on entered information (what vehicle is desired, how long, and is the vehicle presently being used or is it even available). The availability is communicated to the user as claimed.

7. Applicant's arguments filed 10/6/05 have been fully considered but they are not persuasive.

With respect to the limitation of there being no hardware at the designated area, this limitation is considered to be new matter. The examiner notes that applicant's response to the 112,1<sup>st</sup> rejection concerning the limitation of "no hardware" and the position taken by the examiner that it is new matter was never even addressed. The statement by applicant do not even relate to the reasons the claims were rejected. Now, the language in question has changed a little, but is still considered to be new matter.

With respect to the argument that Klein does not disclose a geo fencing means to monitor the use of the vehicle with no hardware at the designated area, what about the GPS system that is disclosed by Klein and that the examiner has referenced in the rejection? Applicant not addressed the fact that the geo fencing means is disclosed as being GPS in the instant specification, and Klein discloses the use of GPS to monitor the vehicles. The argument is non-persuasive. Applicant has not addressed the position taken by the examiner in the rejection itself. An argument that the feature is not taught without addressing the position of the examiner is of little value. The limitation of

no hardware is considered to be new matter and applicant has provided no showing of where support comes from for the claimed limitation.

With respect to the argument that Klein does not disclose a computing means that is responsive to intended use and past vehicle usage in determining if a vehicle is available, the examiner disagrees. Klein is disclosed as determining vehicle availability and this is necessarily based on the user's intended use (when do you need the car, what kind of car, and where are you going), and past vehicle usage in the sense that if the vehicle you want is not at the location you want to rent from, you may not be able to rent it. In this sense the availability would be made based on these factors. Klein discloses a computing means because computer D handles the availability function that is claimed. The argument is non-persuasive.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL  
PRIMARY EXAMINER